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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/801,636

03/17/2004

Koji Kuruma

Q80125

1684

23373 7590 01/09/2008
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EXAMINER

RAMDHANIE, BOBBY

ART UNIT

PAPER NUMBER

1797

MAIL DATE

DELIVERY MODE

01/09/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/801,636

Applicant(s)

KURUMA ET AL.

Examiner

Bobby Ramdhanie, Ph.D.

Art Unit

1797

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 11/17/2007 have been fully considered but they are not persuasive. The following reasons are why:
2. Applicants state that the Ogura 2002/0016009 does not disclose or suggest the recitation that each of the adsorptive region is provided with a signal layer absorbing layer for absorbing a noise signal that comes from a labeled receptor of a labeled ligand having been agglomerated or an enzyme-labeled antibody having clogged the porous adsorptive regions of the biochemical analysis unit. Examiner respectfully disagrees. Ogura teaches these features as well as provides motivation for this feature in [0004].
3. Applicants also state that Ogura 2002/0016009 does not teach a signal absorbing layer for absorbing signal, which passes through the porous adsorptive material of the biochemical analysis unit. Examiner respectfully disagrees. Ogura does teach the claimed invention (see prior office action for rejections). In addition, signal propagation is inherent to all phosphor-imaging type analysis units and is not novel to this particular claimed invention.
4. Applicants state that Ogura (EP1331485) does not disclose the recitation that each of the adsorptive regions is provided with a signal absorbing layer for absorbing a noise signal that comes from a labeled receptor or a labeled ligand having been agglomerated or an enzyme-labeled antibody having clogged the porous adsorptive regions of the biochemical analysis unit. Examiner respectfully disagrees. Examiner takes the position that these claimed features are taught in [0006].

5. In addition, Applicants state, Ogura EP 1331485 does not disclose or suggest a biochemical unit comprising a signal absorbing layer for absorbing signal, which passes through the porous adsorptive material that is connected at the one surface of the base plate, and which thus propagates from a certain hole of the base plate toward an adjacent hole of the base plate. Examiner respectfully disagrees. Ogura does teach the claimed invention (see prior office action for rejections). In addition, signal propagation is inherent to all phosphor-imaging type analysis units and is not novel to this particular claimed invention.

6. Applicants state that Ogura 2003/0003594 does not disclose or teach a biochemical unit comprising a signal absorbing layer for absorbing signal, which passes through the porous adsorptive material that is connected at the one surface of the base plate, and which thus propagates from a certain hole of the base plate toward an adjacent hole of the base plate. Examiner respectfully disagrees. Ogura does teach the claimed invention (see prior office action for rejections). In addition, signal propagation is inherent to all phosphor-imaging type analysis units and is not novel to this particular claimed invention. Examiner would also like to point out labeled receptor teachings in [0005], [0007], and [0011].

7.

Response to Amendment

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

2. Claims 1, 2, 3, 6, and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Ogura (US 20020016009 A1). Regarding Claim 1, Ogura teaches a biochemical analysis unit, comprising: i) a base plate, which has a plurality of holes, and ii) a porous adsorptive material, which is filled in each of the plurality of the holes of the base plate and forms each of a plurality of adsorptive regions, wherein each of the adsorptive regions is provided with a signal absorbing layer for absorbing a noise signal, that comes from a labeled receptor or a labeled ligand having been agglomerated or an enzyme-labeled antibody having clogged the porous adsorptive regions of the biochemical analysis unit (Figure 5, [0251] & [0004], [0007], [0010], & [0011]).

1. For Claim 2, Ogura also teaches a biochemical analysis unit as defined in Claim 1 wherein the base plate is constituted of a material having radiation attenuating properties and/or light attenuating properties (Figure 1, [0233]).

2. For Claims 3 & 6, Ogura teaches a biochemical analysis unit as defined in claim 3 wherein the signal absorbing layer is formed over an entire area of a continuous region of the porous adsorptive material that is connected at the one surface of the base plate (Figure 20, ([0376 - 0379])).

3. For Claim 10, Ogura teaches a biochemical analysis unit as defined in Claim 6, wherein the base plate is constituted of a material having radiation attenuating properties and/or light attenuating properties ([0014]).

4. Claims 1, 2, 3, 5, 7 and 9 are rejected under 35 U.S.C. 102(a) as being anticipated by Ogura (EP 1331485 A2). Regarding Claim 1, Ogura teaches Regarding Claim 1, Ogura teaches a biochemical analysis unit, comprising: i) a base plate, which has a plurality of holes, and ii) a porous adsorptive material, which is filled in each of the plurality of the holes of the base plate and forms each of a plurality of adsorptive regions, wherein each of the adsorptive regions is provided with a signal absorbing layer for absorbing a noise signal, that comes from a labeled receptor or a labeled ligand having been agglomerated or an enzyme-labeled antibody having clogged the porous adsorptive regions of the biochemical analysis unit ([0006], [0009-0010]).

5. For Claim 2, Ogura teaches a biochemical analysis unit as defined in Claim 1, wherein the base plate is constituted of a material having radiation attenuating properties and/or light attenuating properties ([0010]).

6. For Claim 3, Ogura teaches a biochemical analysis unit comprising a base plate, which has a plurality of holes, and a porous adsorptive material, which is filled in each of the plurality of holes of the base plate and forms each of the plurality of adsorptive regions, the porous material which constitutes each of the adsorptive regions, beings connected with the porous adsorptive material, which constitutes an adjacent adsorptive region, at one surface of the base plate, wherein the biochemical analysis unit further comprises a signal absorbing layer for absorbing a signal, which passes through the

porous adsorptive material that is connected at the one surface of the base plate, and which thus propagates from a certain hole of the base plate toward an adjacent hole of the base plate ([0009-0010]] and [0080-0083]).

7. For Claim 5, Ogura teaches a biochemical analysis unit as defined in Claim 3 wherein the signal absorbing layer is formed at only an area, which is located just under each of the adsorptive regions formed in the holes of the plate ([0080-0083]).

8. For Claim 7, Ogura teaches a biochemical analysis unit as defined in Claim 3, wherein the base plate is constituted of a material having radiation attenuating properties and/or light attenuating properties ([0009-0010] and ([0080-0083]).

9. For Claim 9, Ogura teaches a biochemical analysis unit as defined in Claim 5 wherein the base plate is constituted of a material having radiation attenuating properties and/or light attenuating properties ([0073-0074]).

10. Claims 3, 4, and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Ogura (US 0003594). Regarding Claim 3, Ogura teaches a biochemical analysis unit comprising a base plate which has a plurality of holes, and a porous adsorptive material, which is filled in each of the plurality of the holes of the base plate and forms each of a plurality of adsorptive regions, the porous adsorptive material, which constitutes each of the adsorptive regions being connected with the porous adsorptive material, which constitutes an adjacent adsorptive region, at one of the surfaces of the base plate, wherein the biochemical analysis unit further comprises a signal absorbing layer for absorbing a signal which passes through the porous adsorptive material that is connected at the one surface of the base plate, and which thus propagates from a

certain hole of the base plate toward an adjacent hole of the base plate ([0005], [0007], [0011], [0412-0413], & Figure 15).

11. For Claim 4, Ogura teaches a biochemical analysis unit as defined in Claim 3 wherein the signal absorbing layer is formed at only an area of a continuous region of the porous adsorptive material that is connected at the one surface of the base plate, which area is located just under the base plate and is other than the areas of the adsorptive regions formed in the holes of the base plate (Figure 15, [0412-0413]).

12. For Claim 8, Ogura teaches a biochemical analysis unit as defined in Claim 4, wherein the base plate is constituted of a material having radiation attenuating properties and/or light attenuating properties (Figure 15, [0412-0413], [0041]).

Double Patenting

13. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d)

may be used to overcome an actual or provisional rejection based on a nonstatutory

double patenting ground provided the conflicting application or patent either is

shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

14. Claims 6 & 10 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 68 of copending Application No. 09/918500. Although the conflicting claims are not identical, they are not patentably distinct from each other because Claims 6, and 10, Claims 6 & 10 of the instant application recite, "A biochemical analysis unit as defined in claim 3 wherein the signal absorbing layer is formed over an entire area of a continuous region of the porous adsorptive material that is connected at the one surface of the base plate (see lines 10-20 Claim 68). Claim 10 recites, "A biochemical analysis unit as defined in Claim 6 wherein the base plate is constituted of a material having radiation attenuating properties and/or light attenuating properties (See lines 4-5 Claim 68). Claim 10 in the application is dependent on Claim 6. Although the conflicting claims are not identical, they are not patentably distinct from each other because in the prior application, Claim 68 teaches the claimed invention of Claims 6 & 10 in the instant application. For double patenting to exist as between the rejected claims and claims in the prior application, it must be determined that the rejected claims are not patentably distinct from the claims in the prior application. In order to make this determination, it first must be determined whether there are any differences between the rejected claims and Claim 68, and if so,

whether those differences render the claims patentably distinct. The difference between Claims 6 & 10 of the instant application and Claim 68 of the prior application lies in the fact that the prior application claim includes more information about where the type of substances that bind to the signal absorbing layer are come from, thus much more specific. Thus the invention of claim 68 of the prior application is in effect a "species" of the "generic" invention of Claims 6 & 10 of the application. It has been held that the generic invention is "anticipated" by the "species." See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993). Claims 6 & 10 of the instant application anticipate Claim 68 of the prior application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bobby Ramdhanie, Ph.D. whose telephone number is 571-270-3240. The examiner can normally be reached on Mon-Fri 8-5 (Alt Fri off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Walter Griffin can be reached on 571-272-1447. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BR


WALTER D. GRIFFIN
SUPERVISORY PATENT EXAMINER